

Application No. 09/448,088

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Claim Rejections 35 U.S.C. §103

Claims 1 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pettersen et al (US 5,805,287) in view of Lepper et al. (US 5,555,504). This rejection is respectfully traversed.

Claim 1 recites a system for identification and tracking of tags distributed in a room, wherein the system includes a laser base station for scanning laser beams a tag reactive to incident laser beams to provide a data signal, and a tag tracking system receiving input from the laser base station, the tag tracking system storing state records of position and informational content of the tag.

Claim 1 should be allowed as the Examiner has failed to establish a prima facie case of obviousness.

Claim 1 should be allowed as the Examiner has failed to identify any suggestion to combine the references in either of the references or the prior art. To sustain a prima facie case of obviousness based upon a combination of references, the Examiner must point to some suggestion to combine the references. "The prior art must suggest the desirability of the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01.

Further, this suggestion must be found in the prior art, and cannot be based upon Applicants' disclosure. Recently, the Court of Appeals for the Federal Circuit (CAFC) addressed this issue in re Lee 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed Cir. 2002).

In Lee, the Examiner rejected the claims on the ground of obviousness, citing the combination of two references: United States Patent No. 4,626,892 to Nortrup, and the Thunderchopper Helicopter Operations Handbook for a video game. The Nortrup reference described a television set having a menu display by which the user can adjust various picture and audio functions. However, the Nortrup display did not include a demonstration of how to

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adjust the functions. The Thunderchopper Handbook described the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game. However, the Thunderchopper Handbook made no mention of the adjustment of picture or audio functions. The Examiner held that it would have been obvious to a person of ordinary skill to combine the teachings of these references to produce the Lee system. Lee appealed to the Board of Patent Appeals and Interferences (Board), arguing that the Thunderchopper Handbook simply explained how to play the Thunderchopper game, and that the prior art provided no teaching or motivation or suggestion to combine this reference with Nortrup, or that such combination would produce the Lee invention. The Board held that it was not necessary to present a source of a teaching, suggestion, or motivation to combine these references or their teachings. The Board stated, "The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

The CAFC reversed the Board stating "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." "With respect to Lee's application, neither the Examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described." Lee 277 F.3d 1343.

While Applicants do not acknowledge disclosure of the elements of the claimed invention by the references, Applicants submit that the Examiner has not identified any suggestion in any of the references to combine the various features allegedly taught by their respective references to achieve the invention claimed in this patent application.

The Examiner has failed to establish that the references suggest the desirability of the inventions disclosed in claim 1. The Examiner has suggested that it would be obvious to combine the disclosures of Pettersen et al. and Lepper et al. to achieve Applicants'

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invention. However, the Examiner has pointed to nothing in either Pettersen et al or Lepper et al. that suggests the desirability of a system for identification and tracking of tags distributed in a room, wherein the system includes a laser base station for scanning laser beams a tag reactive to incident laser beams to provide a data signal, and a tag tracking system receiving input from the laser base station, the tag tracking system storing state records of position and informational content of the tag. The fact that the disclosure of Pettersen et al and the disclosure of Lepper et al. can be combined does not by itself support a conclusion of obviousness. "The mere fact that references can be combined is not sufficient to establish prima facie obviousness." MPEP 2143.01.

The Examiner may be of the position that the invention claimed in the present application would be obvious to try after reviewing the cited references. Obvious to try, however, is not the standard by which obviousness is determined under 35 U.S.C. §103. In re Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); In re Yates, 211 U.S.P.Q. 1149 (CCPA 1981); In re Goodwin, 576 F.2d 375, 198 U.S.P.Q. 1 (CCPA 1978).

Additionally, Applicants note that the Examiner asserts that Pettersen et al. discloses a laser base station. The Examiner, however, points to no specific passage disclosing a laser, let alone a laser base station. Applicant can see no mention of a laser in Pettersen et al. Pettersen et al. do disclose using a light pen as a reading device. However, a light pen emits incoherent light and not laser light.

Claim 4 should be allowed as it depends from claim 1.

Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Pettersen et al as modified by Lepper et al. as applied to claim 1 above, and further in view of Teitel et al (US 5,812,257). This rejection is respectfully traversed.

Claim 2 should be allowed as the Examiner has failed to identify any suggestion to combine the references in any of the references or the prior art. Applicants have already argued that Examiner has not pointed to any motivation to combine the disclosures of Pettersen et al. and Lepper et al. The Examiner has also failed to identify a

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motivation in either Lepper et al. or Pettersen et al for combining with the angular position calculation features of Teitel et al. Examiner is again reminded that she cannot use Applicants' disclosure to provide this motivation.

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Pettersen et al as modified by Lepper et al. as applied to claim 1 above, and further in view of Kibrick (US 4,901,073). This rejection is respectfully traversed.

Claim 3 should be allowed as the Examiner has failed to identify any suggestion to combine the references in any of the references or the prior art. Applicants have already argued that Examiner has not pointed to any motivation to combine the disclosures of Pettersen et al. and Lepper et al. The Examiner has also failed to identify a motivation in either Lepper et al. or Pettersen et al for combining with the absolute position calculation features of Kibrick. Examiner is again reminded that she cannot use Applicants' disclosure to provide this motivation.

Claims 5-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pettersen et al as modified by Lepper et al. as applied to claim 1 above, and further in view of Moran et al (US 6,005,482). These rejections are respectfully traversed.

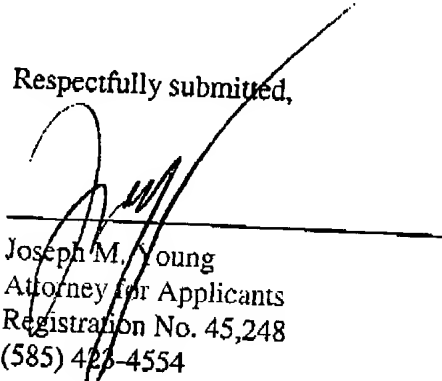
Claims 5-8 should be allowed as the Examiner has failed to identify any suggestion to combine the references in any of the references or the prior art. Applicants have already argued that Examiner has not pointed to any motivation to combine the disclosures of Pettersen et al. and Lepper et al. The Examiner has also failed to identify a motivation in either Lepper et al. or Pettersen et al for combining with the internally powered radio and acoustic tags mentioned in Moran et al. Examiner is again reminded that she cannot use Applicants' disclosure to provide this motivation.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also

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constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Respectfully submitted,



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